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1999 conforms to 37 CFR 1.98(a)(1). The disclosed patent documents and publications were submitted in application 09/911,036 from which the present application claims priority under 35 USC 120. Therefore, it is submitted copies need not be provided. Consideration of the references made of record in the IDS is therefore respectfully requested.

The specification has been amended to clarify that the present application claims benefits to provisional patent application no. 60/023,903 filed August 14, 1996.

The Examiner has rejected claims 22 and 23 under 35 USC 112. This rejection of claims 22 and 23 under 35 U.S.C. 112 is not understood by the applicants' agent. The Examiner asserts he does not understand "how a data message is sent from a data terminal to the same terminal". Claim 22, however does not claim sending a data message from a data terminal to the same terminal. Claim 22, claims "receiving a second data message from said data terminal". This "second data message is indicative of a call disposition response provided to the data terminal", as claimed. The call disposition message is not provided to "incoming call", as assumed by the Examiner. It is provided by the data terminal and indicates a call disposition response, which may for example be received by the data terminal from an end user. Once the call disposition message is received, the call may be completed to the specified subscriber line, as claimed in claim 23. Claims 22 and 23 and those dependent thereon, it is therefore submitted, comply with 35 USC 112. Withdrawal of the rejection of these claims is therefore requested.

The Examiner has again rejected independent claims 21, 29 under 35 USC 102 as being clearly anticipated by U.S. Patent No. 5,805,587 to Norris ("Norris"). The Examiner has likewise rejected dependent claims 22-28; 30-31; 33-34 in view of Norris. The applicants continue to respectfully disagree.

Specifically, Norris fails to disclose use of a signaling network for carrying

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signaling information relevant to the establishment of call paths on a traffic carrying network. As clearly claimed in claims 21 and 29, this signaling network carries signaling information for telephone call traffic for a switched traffic network made up of a plurality of telephony switches. Norris simply discloses use of an ISDN network, no separate signaling network is disclosed. Without such an explicit disclosure, Norris cannot anticipate claims 21 and 29. Similarly Norris does not disclose "receiving a signaling message from this signaling network generated in response to said incoming call, and received prior to establishment of a call path for the incoming call on the traffic carrying network", as claimed in independent claim 21; nor a network interface operable to receive signaling messages prior to establishment of associated call paths on the traffic carrying telephony network, as claimed in independent claim 29.

In one embodiment, Norris routes a transferred call to the IAS using convention T1 carrier lines. As disclosed in column 2, lines 23-38 of Norris,

"Assuming that IAS 200 is not located in the same local dialing region as terminal DT1, then the telephone call will be routed via the public switched network (PSN) 100 e.g., the AT&T network. Specifically, upon receipt of the dialed number, then CO 25, in a conventional manner establishes a telephone connection to toll switch (TS) 105 and passes the called number and the ANI associate with the line 10 to TS 105. TS 105, in turn and in a conventional manner, establishes a connection to IAS 200 via communication path 150. ... TS 105 thus routes the call to IAS 200 by sending a so-called call set-up message over the signaling channel, in which the message identifies, inter alia, the T1 channel carrying the incoming call, ..."
[EMPHASIS ADDED]

Thus as this passage clearly indicates, the call is transferred to the IAS over the communications path. The signaling message is received at the IAS identifying a T1 channel to the IAS, with the call, and not prior to establishment of a call path for

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the incoming call, as claimed.

In another embodiment, Norris routes the incoming call to the IAS of Norris via an ISDN B (bearer) and D (data) channel (see column 5, line 48 – column 6, line 15). ISDN B channels carry traffic, and define a call path on a traffic carrying network. Specifically, the passage of Norris relied on by the Examiner (column 5 line 66 – column 6, line 11) simply discloses,

“To re-route the call, TS 105 signals IAS 200 (PBX235) that a call is being routed (forwarded) thereto via an idle B channel serving the particular call type, in which such signaling is transmitted over the associated D signaling channel. (As mentioned above, if the call is being forwarded to IAS 200, then the toll switch routes the call communications path 150-10. Calls directed to Internet 300, on the other hand, are routed over communications path 150-11.) The signaling information that is transported over a D channel of path 150-10 includes, inter alia, the forward-to-number used by CO 25 and the ANI of station S1. Such information may also include the calling party telephone number (station S2).”

Thus again it appears in Norris that signaling messages are passed on D channels as call paths are established on the associated B channels. No signaling messages appear to be received prior to establishment of call paths.

As Norris simply does not explicitly disclose each and every element of claim 21 or 29, as required for anticipation under 35 USC 102, it cannot anticipate these claims. Withdrawal of the rejection of independent claims 21 and 29, and claims 22-23; 25-28; 30-31; and 33-35 dependent thereon in view of Norris is therefore respectfully requested.

The Examiner has further rejected claims 32, 36-37, 39-43, and 50-61 under 35 USC 103 in view of Norris and newly cited U.S. Patent No. 6,038,305 to

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McAllister ("McAllister").

McAllister issued on March 14, 2000 from an application filed on August 1, 1997, and claims continuation-in-part status from an application filed March 28, 1997. The present application, on the other hand, claims priority from U.S. Patent Application No. 08/911,036, which claims benefits of U.S. Patent Application No. 60/023,903 filed August 14, 1996. As the earliest date the present application is entitled to predate the earliest filing date of McAllister, McAllister is not a proper cite under 35 USC 102(e) and 35 USC 103. Rejections of claims 32, 36-37, 39-43, and 50-61 under 35 USC 103 in view of Norris and McAllister is therefore improper. Withdrawal of these rejections is therefore requested.

As noted in response to the previous Office Action, in order to reject claims under 35 USC 103, the Examiner must establish that all claim elements exist in the art and a motivation to combine the art to arrive at the claimed invention at the date the invention was made.

Applicants do not dispute that the AIN is known (this is for example further evidenced by U.S. Patent No. 5,533,106 to Blumhardt ("Blumhardt")). However, the Applicants do dispute that at the date the invention was made, knowledge of the existence of AIN and Norris would have lead a person of ordinary skill to use AIN to effect the dispatch of signaling messages over a data network, as claimed. Any such suggestion, it is submitted, is made with impermissible hindsight.

Specifically, as evidenced by U.S. Patent No. 5,884,262 to Wise ("Wise") and Blumhardt, the AIN is used to effect signaling and call completion over the telephone signaling network. It primarily allows benefits in conjunction with signaling provided to the PSTN for call handling. As such, Blumhardt uses the AIN to control call disposition; Wise uses AIN to provide Internet-type access to callers. Internet call notification devices, as disclosed by Norris, on the other hand primary receive signaling from the PSTN. This is further evidenced by U.S. Patent No. 5,809,128 to

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McMullin ("McMullin") and U.S. Patent No. 5,982,774 to Foladare et al. ("Foladare").

Further, at the time of Norris, internet call notification appears to be have been provided in co-operation with an internet access provider (IAP), or a separate server. At the date the invention was made, PSTN signaling messages were easily provided from the PSTN to the IAP or separate server using other existing technologies, such as existing call busy/no answer forwarding features disclosed by Norris, McMullin and Foladare. Use of AIN signaling, that required some modification to the PSTN network appeared unnecessary, in view of the ability to use the existing technologies. Indeed, it is submitted that, adapting the telephone network to primarily provide signaling messages from the PSTN using AIN for dispatch of data network notification (e.g. internet notification) messages, without establishing corresponding voice carrying PSTN channels was, at the date the invention was made (i.e. on or before Aug. 14, 1996), a radical departure from what is suggested by Norris. AIN signaling provides benefits to the PSTN operator in the delivery of internet notification – voice channels are not unnecessarily established. Providers of internet notification, such as Norris, although likely aware of the existence of AIN, appeared to have had little motivation to improve PSTN operation. As such, benefits provided in internet call notification through use of AIN would not have been recognized by a person of ordinary skill, on the date the invention was made. In view of other existing technologies, they would not have been motivated to combine internet call notification with AIN. Any suggestion by the Examiner that persons of ordinary skill would have been so motivated, it is submitted, uses impermissible hindsight found in the present application.

No new matter has been added by this amendment.

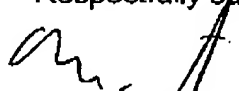
Attached hereto is a marked-up version of the changes made to the specification by the current amendment. The attached page is captioned "Version with markings to show changes made".

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In view of the foregoing, favorable reconsideration and allowance of the present application are earnestly solicited.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION

Replace the paragraph beginning on page 1 beginning with "This is a continuation application of U.S. Patent Application No. 08/911,036." with
-- This is a continuation application of U.S. Patent Application No. 08/911,036, claiming priority from U.S. Provisional Patent Application No. 60/023,903.--